

REMARKS

Claims 1-25 are in this application.

In the office action claims 1-25 are rejected under 35 U.S.C. § 103(a) as unpatentable over, U.S. Patent No. 5,474,235 to Cole et al in view of U.S. Patent No. 5,325,732 to Vogel. The rejections are respectfully traversed for at least the following reasons.

It is well-settled that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). Further, “obvious to try” is not the standard under 35 U.S.C. §103. *In re Fine*, 5 U.S.P.Q. 2d 1596, 1599 (Fed. Cir. 1988). And, as stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988).

Considering the law in light of the present facts, it is respectfully submitted that the Examiner has failed to provide any motivation to combine the teachings of Cole and Vogel. The two references are in very different classification, which suggest that they concern matters which would not be readily looked to for combination. Further, it is respectfully submitted that one working with devices concerning spray nozzles such as that described by Cole, would be unlikely to look to art concerning shaft and liner bearings using a polymer member as one bearing, or an aluminum screw with composite nut as described in two of the Examples in Vogel.

Further, as previously pointed out by the Examiner the device described in Cole, already includes a lubricating coating of Teflon. Thus there is no suggestion in Cole that this coating is insufficient for its intended purpose or that there is any need to apply a Teflon impregnated metal coating. The only suggestion that the Teflon coating of Cole is ineffective and therefore requires a different plating comes from the instant application. Similarly, Vogel does not seek to overcome limitations in the prior art related to coating with Teflon, but rather to overcome the drawbacks of applying dry lubricant after manufacture of machine parts. (Col. 1. lines 39-51). As the examiner is aware the application itself cannot provide the suggestion to combine reference. Accordingly, because it is submitted that the Examiner has improperly combined references for which the only suggestion of combination comes from the instant application itself, it is requested that the rejection be withdrawn.

Conclusion

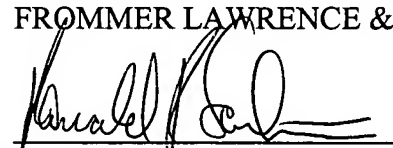
In the event the Examiner disagrees with any of statements appearing above with respect to the disclosures in the cited reference, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable and Applicants respectfully request early passage to issue of the present application.

Respectfully submitted,
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